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EXAMINER

HIGGINS, GERARD T

ART UNIT	PAPER NUMBER
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1785

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01/04/2011

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/822,567

Applicant(s)

BURROW ET AL.

Examiner

GERARD T. HIGGINS

Art Unit

1785

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 October 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 29-33, 35, 37-42, 45 and 46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 29-33, 35, 37-42, 45 and 46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. Applicant's amendment filed on 10/28/2010 has been entered. Currently claims 29-33, 35, 37-42, 45, and 46 are pending, claims 1-28, 34, 36, 43, and 44 are cancelled, and claims 45 and 46 are new.

Specification

2. The disclosure is objected to because of the following informalities:

In the specification amendment filed 12/09/2008, the phrase "This application is a divisional of US patent 5,961,150" is objected to because that is not correct. This application is a divisional of Application 09/656258 which is US patent 6,740,189.

Appropriate correction is required.

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

The limitations of original claim 3 now incorporated into present claims 30 and 40 that the image sheet and the member were formed of a flexible "plastic material" was not properly disclosed in the specification as originally filed.

Claim Objections

4. Claims 29, 37-39, 42, 45, and 46 are objected to because of the following informalities:

In claims 29, 37, and 38 the phrase "being a member of the group consisting of a portfolio, desk folder, binder, wallet, luggage tag, memo pad or keyfob" is objected to grammatically. The objection can be overcome by changing the phrase to "is a member of the group consisting of a portfolio, a desk folder, a binder, a wallet, a luggage tag, a memo pad and a keyfob" which is how the claims will be interpreted.

In claim 29, the phrase "including the printed image on a first side thereof" on the 7th line of the claim is objected to grammatically because the phrase could be referring to the member and not the image film. The objection can be overcome by changing the phrase to "wherein the image film includes the printed image on a first side thereof" which is how the claim will be interpreted.

In claim 29, the phrase ", said image film further comprising a thin transparent laminate sheet" is objected to grammatically because the image film does not comprise the transparent laminate sheet as they are separate entities. This objection can be overcome by changing the phrase to "; and a transparent laminate sheet" which is how the claim will be interpreted. In this way the claim would recite the 3 main elements: the cover part; the image film; and the transparent laminate sheet.

In claim 29, the phrase ", the image film with transparent laminate thin sheet being cut" on the 9th line of the claim is objected to grammatically. The objection can be

overcome by changing the phrase to “; wherein the image film with the transparent laminate sheet is cut” which is how the claim will be interpreted.

In claim 29, the phrase “; said image film being in contact” on the 11th line of the claim is objected to grammatically. The objection can be overcome by changing the phrase to “, said image film is in contact” which is how the claim will be interpreted.

In claim 29, the phrase “; and said member having an indentation in a surface thereof, in which said image film is received when bonded, said indentation having” on the 15th to 16th lines of the claim is objected to grammatically. The objection can be overcome by changing the phrase to “, said member has an indentation in its surface where said image film is received when bonded, and said indentation has” which is how the claim will be interpreted. In this way, the further limitations of the 9th through the 17th lines of the claim (see the preceding two paragraphs) will be recited as a list.

In claim 37, the phrase “and comprising at least a portion of a cover part of said article” is objected to grammatically because the member is apart of the cover part and not the reverse. The objection can be overcome by changing the phrase to “, wherein the member is at least a portion of a cover part of said article” which is how the claim will be interpreted.

In claim 37, the phrase “on the first side of the image film” on the 7th line of the claim is objected to grammatically because this phrase can refer to either where the printed image is located or how the image film is cut. This objection can be overcome by changing the limitation to “, wherein the printed image is on the first side of the image film” which is how the claim will be interpreted.

In claim 37, the phrase "and wherein the image film further comprises a transparent laminate sheet" on the 8th to 9th lines of the claim is objected to grammatically. This objection can be overcome by changing the limitation to "; and a transparent laminate sheet" which is how the claim will be interpreted. In this way the claim would recite the 3 main elements: the member; the image film; and the transparent laminate sheet.

In claim 37, the phrase "an indentation in a surface of said member having" on the 11th line of the claim is objected to grammatically. The objection can be overcome by changing the phrase to "wherein an indentation in a surface of said member has" which is how the claim will be interpreted.

In claim 37, the phrase "said image film being permanently welded" on the 14th line of the claim is objected to grammatically. The objection can be overcome by changing the phrase to "said image film is permanently welded" which is how the claim will be interpreted.

In claim 38, the phrase "having a cover part comprising a flexible and indentable material and an image sheet of a flexible material having first and second sides and having the printed image on said first side of said image sheet, wherein said printed image is comprised of ink;" on the 3rd to 5th lines of the claim is objected to grammatically because it can be referring to either the article or the keyfob. The objection can be overcome by changing the phrase to ", wherein the article has(comprises) a cover part comprising a flexible and indentable material; an image sheet of a flexible material having first and second sides, wherein the printed image is

on said first side of said image sheet and said printed image is comprised of ink;" which is how the claim will be interpreted.

In claim 38, the phrase "and wherein said image sheet further comprises a transparent laminate sheet" on the 6th line of the claim is objected to grammatically. This objection can be overcome by changing the phrase to "and a transparent laminate sheet" which is how the claim will be interpreted. With this correction and with the preceding paragraph the claim would recite the 3 main elements: the cover part; the image sheet; and the transparent laminate sheet.

In claim 38, the phrase ", the image sheet and transparent laminate sheet being cut precisely" on the 7th line of the claim is objected to grammatically. The rejection can be overcome by changing the limitation to "; wherein the image sheet and transparent laminate sheet are cut precisely" which is how the claim will be interpreted.

In claim 38, the phrase "the cover part including a planar debossed indentation" on the 9th line of the claim is objected to grammatically. The objection can be overcome by changing the phrase to "the cover part includes a planar debossed indentation" which is how the claim will be interpreted.

In claim 39, the phrase "and said image sheet being welded" on the 10th line of the claim is objected to grammatically. The objection can be overcome by changing the phrase to "and said image sheet is welded" which is how the claim will be interpreted.

In claim 39, the phrase "the planar indentation" is objected to grammatically. The objection can be overcome by changing the limitation to "the planar debossed indentation" which is how the claim will be interpreted.

In claim 42, the phrase "of a substrate and ink receptive coating" is objected to grammatically. The objection can be overcome by changing the limitation to "of a substrate and an ink receptive coating" which is how the claim will be interpreted.

In claims 45 and 46, the phrase "the laminate sheet" is objected to grammatically in each claim. The objection can be overcome by changing the limitation in each claim to "the transparent laminate sheet" which is how the claim will be interpreted.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. Claims 29-33, 35, 37, 39-42, 45, and 46 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

With regard to claims 29-33, 35, and 37, the Examiner does not find support for "an image film of a flexible material of about 4.0 mils to about 12.0 mils" or the usage of the term image "film" in the specification as originally filed. These thicknesses and the recitation of image "film" are for the specific embodiment of polyvinyl chloride and not for any image sheet generally. Applicants do not have support to make any image sheet of these thicknesses. This rejection can be overcome by limiting the claims to a PVC film of these thicknesses *or* by changing the limitations back to an "image sheet" in each of claims 29-33, 35, and 37 and deleting the thicknesses from claims 29 and 37.

With regard to claims 37, the Examiner does not find support for "precisely" cutting only the transparent laminate sheet and not cutting the image sheet "precisely" in the specification as originally filed. The context at page 12, lines 3-5 state that the image sheet is at least precisely cut and optionally a protective laminated sheet as well. Given applicants' disclosure and the way the claim is written, this rejection can be overcome by changing the phrase "and cut according to contours" on the 7th line of the claim to "that is cut precisely according to the contours".

With regard to claims 45 and 46, the Examiner does not find support to state that any transparent laminate sheet "is a film about 4.0 mils thick" in the specification as originally filed. The recitation of a "film about 4.0 mils thick" is with regard to the image sheet and not the transparent laminate sheet; further, the recitation of "4.0 mils" is for the specific embodiment of a PVC sheet and not for any transparent laminate sheet generally. This rejection can be overcome by changing these limitations to "is a sheet of polyvinyl chloride that is about 4.0 mils thick" or "is an overlay of polyvinyl chloride that is 4.0 mils thick".

6. Claims 29-33, 35, and 38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With regard to claim 29, the term "thin transparent laminate sheet" is a relative term which renders the claim indefinite. The term "thin transparent laminate sheet" is not defined by the claim, the specification does not provide a standard for ascertaining

the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The thin transparent laminate only has one exemplary thickness which is not a specific definition of the layer, and therefore it is unclear what range of layers would be considered "thin". For purposes of examination, any thickness will be treated as being thin.

Claim 29 recites the limitation "said image sheet" in the 17th line of the claim. There is insufficient antecedent basis for this limitation in the claim. For purposes of examination this will be treated as "said image film".

With regard to claim 38, the limitation that "the planar indentation has a depth at least as great as the thickness of said image sheet so as to recess said image sheet in said member" renders the claim indefinite because the word "recess" means that the image sheet is set back into the indentation. This is at odd with the limitation that the indentation has "a depth at least as great as the thickness of said image sheet" because if the depth equaled the thickness of the image sheet that would not be recessed. These broad and narrow limitations in the same claim render the claim indefinite. This rejection can be overcome by deleting "so as to recess said image sheet in said member" which is how the claim will be interpreted.

Claim 38 recites the limitation "said member" in the 13th line of the claim. There is insufficient antecedent basis for this limitation in the claim. For purposes of examination, this limitation will be treated as "said cover part".

Claim 39 recites the limitation "said image sheet" in the 2nd line of the claim. There is insufficient antecedent basis for this limitation in the claim. For purposes of examination this will be treated as "said image film".

Claim 40 recites the limitation "said image sheet" in the 1st line of the claim. There is insufficient antecedent basis for this limitation in the claim. For purposes of examination this will be treated as "said image film".

Claim 42 recites the limitation "said image sheet" in the 2nd line of the claim. There is insufficient antecedent basis for this limitation in the claim. For purposes of examination this will be treated as "said image film".

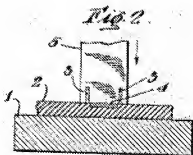
Claim Rejections - 35 USC § 103

7. Claims 29-31, 35, 37-41, 45, and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Larmour (2,237,152) in view of Nemoto (4,781,779) and Scopp (3,725,185).

The Examiner notes various product-by-process limitations in applicants' claims, including that RF energy is used to adhere/weld said image sheet to said member (claims 38). It has been held that "even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." Please see MPEP 2112 and *In re Thorpe*, 777 F.2d 695, 698, 227

USPQ 964, 966 (Fed. Cir. 1985). Any article that has the resulting article limitations will be held to render obvious applicants' claimed article.

With regard to claims 29, 30, 37-41, 45, and 46, Larmour discloses the method of inlaying ornaments in the surface of articles and the inlaid article of Figure 2.



The article can be for any decorative use generally (page 2, right col. lines 1-7). The Examiner notes that while there is no disclosure that the article is an "portfolio, desk folder, wallet, luggage tag, memo pad, or keyfob" as presently claimed, applicants attention is drawn to MPEP 2111.02 which states that "if the body of a claim fully and intrinsically sets forth all the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention's limitations, then the preamble is not considered a limitation and is of no significance to claim construction". Further, MPEP 2111.02 states that statements in the preamble reciting the purpose or intended use of the claimed invention must be evaluated to determine whether the purpose or intended use results in a structural difference between the claimed invention and the prior art. Only if such structural difference exists, does the recitation serve to limit the

claim. If the prior art structure is capable of performing the intended use, then it meets the claim.

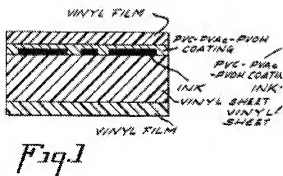
It is the examiner's position that the preamble does not state any distinct definition of any of the claimed invention's limitations and further that the purpose or intended use, i.e. as a "portfolio, desk folder, wallet, luggage tag, memo pad, or keyfob", recited in the present claims does not result in a structural difference between the presently claimed invention and the prior art, and further that the prior art structure which is an inlaid article identical to that set forth in the present claims is capable of performing the recited purpose or intended use.

The article has an ornament **4**, which reads on applicants' image film or image sheet that is being inlaid into the material **2**, which reads on applicants' cover part and/or member. The material **2** can be made of synthetic resin compounds (page 1, left col., lines 32-35). The ornament may be pressed into the material such that an indentation is formed which will be at least as deep as the thickness of the ornament (see Figure 2 and also page 2, left col., lines 51-56). Given the fact that the material is being deformed, it is clearly a flexible and indentable material; however, Larmour does not disclose the thickness of the image film (claims 29, 37, 45, and 46), that the image film/sheet is a flexible plastic material particularly PVC possessing a printed image of ink with a transparent laminate sheet thereover (claims 29, 30, 37-41), or that the image is cut precisely to the contours of the printed image thereon (claims 29, 37, and 38).

Nemoto discloses a method of high frequency welding a decorative strip, preferably of PVC, to a substrate, also preferably of PVC (col. 2, lines 48-58). This

method is of the same of press inlaying as is taught in Larmour (see Figures 3-5). The decorative strip is taught to be die cut in a predetermined shape, i.e. as a letter (see Figure 5 and col. 2, lines 55-58).

Scopp teaches the coated vinyl film of their Figure 1.



The coated vinyl film may be a laminated vinyl sheet core of PVC, which reads on applicants' image film/sheet (col. 3, line 66 to col. 4, line 6). The vinyl film may be PVC as well, which reads on applicants' transparent laminate sheet (col. 4, lines 12-18). The thickness of the vinyl sheet is in the range of 0.010 in (10 mil) to about 0.030 (30 mil) and the film may have a thickness of 1 to 3 mils, wherein this means Scopp teaches a vinyl sheet of 10 mils and a vinyl film of 3 mils (col. 4, lines 55-60).

Since Larmour and Nemoto are drawn to decorative inlaying using a press/heating system; it would have been obvious to one having ordinary skill in the art at the time the invention was made to have press welded a die cut PVC decorative element into a PVC substrate as taught by Nemoto for the article of Larmour. The result of such a substitution would have been predictable to one having ordinary skill in the art because these are known elements that are being manufactured using the same overall

process. Another rationale to use all PVC based products is that one could decorate a substrate and not have to buy diverse materials; hence, saving on production costs.

Additionally, since Larmour in view of Nemoto are drawn to a usage of polyvinyl chloride films; it would have been obvious to one having ordinary skill in the art to have used the vinyl films of Scopp as the PVC decorative element of Larmour in view of Nemoto. The result of such a substitution would have been predictable to one having ordinary skill in the art. The rationale to use the vinyl films of Scopp is that multicolored images can be printed in the ink, and therefore the ultimate inlaid product would be more aesthetically pleasing and varied. If the printed vinyl films of Scopp are die cut according to the printed image as taught by Nemoto the resulting inlaid film will have the image film/sheet and transparent laminate sheet cut precisely according to the contours of the printed image and will be permanently welded in the indentation as claimed.

With specific regard to the product-by-process limitations of claims 31 and 38 that RF energy is used to adhere/weld said image sheet to said member, the high frequency welding process of Nemoto would result in a structurally indistinguishable product.

With specific regard to claims 45 and 46, the Examiner notes that 3 mils is "about 4 mils" as claimed; alternatively, it would have been obvious to one having ordinary skill in the art to have adjusted the thickness of the vinyl film to any amount including 4.0 mils as claimed. The results of such a modification would have been obvious as it would provide further protection to the printed image.

8. Claims 32, 33, and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Larmour (2,237,152) in view of Nemoto (4,781,779) and Scopp (3,725,185) as applied to claims 29 and 37, respectively, in view of Miyamoto et al. (4,460,637).

Larmour in view of Nemoto and Scopp render obvious all of the limitations of applicants' claims 29 and 37 in section 7 above; however they fail to disclose that there is an ink receptive layer on the image film.

Miyamoto et al. also teach that it is known to place ink receptive layers on thermoplastic support materials, including polyvinyl chloride (col. 6, lines 47-63).

Since Larmour, Nemoto, Scopp, and Miyamoto et al. are drawn to printing of images on PVC; it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the image film of Larmour in view of Nemoto and Scopp have an ink receptive layer on the image film as taught by Miyamoto et al. The motivation for using an ink receptive layer can be found at col. 1, lines 5-11 of Miyamoto et al. where they state that their recording sheet has high density and bright colors for the recorded images and also a high rate of ink absorption with a minimum of ink feathering.

With specific regard to claim 33, any surface intrinsically has a texture, and therefore the vinyl sheet rendered obvious for the image film will meet this claim.

Response to Arguments

9. Applicant's arguments with respect to claims 29-33, 35, 37-42, 45, and 46 have been considered but are moot in view of the new ground(s) of rejection.

The new limitations in applicants' claims 29, 37, and 38 necessitated the new grounds of rejection set forth above.

The limitations that the image film/sheet is "about 4.0 mils to about 12.0 mils" in claims 29 and 37 necessitated the new rejections above because as applicants correctly pointed out on page 9 of their Remarks that such a film could not be press fit or snap fit into the book binding.

The limitations that a transparent laminate sheet "bonded to and overlaying the printed image" in claims 29 and 38 also necessitated the new rejections above because the previous rejection had a transparent laminate sheet that was not bonded or directly bonded to the image film/sheet.

The limitations that the transparent laminate sheet is "cut precisely according to the contours of the printed image" in claims 37 and 38 also necessitated the new rejections above because the claims did not previously require this specific structural limitation.

Applicants argue on page 10 of their Remarks that the references did not teach or suggest the limitation that the indentation has "a depth at least as great as the thickness of said image sheet".

The Examiner respectfully disagrees and notes that a *prima facie* case of obviousness was set forth on page 5 of the Office action mailed 04/28/2010. The Examiner set forth a *prima facie* case to adjust the depth of the indentation of Errichiello to be any amount, including at least as great as the thickness of the image sheet, in order to arrive at a book binder that had a cover panel that was smooth while still maintaining structural stability of the cover panel. Applicants' arguments do not address this *prima facie* case of obviousness of adjusting thicknesses/depths.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GERARD T. HIGGINS whose telephone number is (571)270-3467. The examiner can normally be reached on M-F 10am-8pm est. (Variable one work-at-home day).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Ruthkosky can be reached on 571-272-1291. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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